REMARKS/ARGUMENTS

Prior to entry of this amendment, the application included claims 1-38. A first office action mailed March 25, 2005 (the "initial office action") rejected claims 1-33 under 35 U.S.C. § 103(a) as unpatentable over US Patent No. 6,073,242 to Hardy et al. ("Hardy") in view of the article entitled "Understanding And Deploying LDAP Directory Services" by Howes et al. ("Howes"). An amendment (the applicants' "prior amendment") mailed claims 7, 8, 18, 19, 28 and 29, and added new claims 34-38. A final office action mailed August 1, 2005 (the "final office action") rejected claim 38 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement and rejected claims 1-37 were rejected under § 103(a) as being unpatentable over the combination of Howes and Hardy.

This amendment neither amends, cancels nor adds any claims. Hence, after entry of this amendment, claims 1-38 remain pending for examination.

§ 112 Rejection

The final office action rejected claim 38 under § 112, ¶ 1 as failing to comply with the written description requirement. Specifically, the final action asserted that lines 17-19 on page 47, which disclose that "The event catalog, which will be discussed in more detail below, is a list of events that trigger actions (e.g., cross application workflows) external to the workflow." The applicants respectfully submit that this disclosure does support the elements of claim 38, which recites "wherein at least one of the first program and the second program is external to the workflow." The applicants further suggest that perhaps the Office misread the cited portion of the application, which the Office quotes as disclosing "User Manager. Or, they must be performed by the Group Manager, etc. Figure 20 is a flowchart describing the process of using a workflow. The process of Figure 20 is performed, for example, when creating a new user; a new ..." The language quoted by the office action actually can be found on lines 17-19 of page 46, not page 47 as attributed by the office action. Hence, the applicants respectfully request reconsideration of the § 112 rejection in light of the correct portion of the specification.

Moreover, the elements of claim 38 are supported by other portions of the application as well. Merely by way of example, page 48, lines 18-22 describes that "[t]he event catalog, which will be discussed in more detail below, is a list of events that trigger actions (e.g. cross application workflows) external to the workflow. In one embodiment, the event catalog is only checked if the template allowed for the use of external actions. For example, one of the actions allowed in a workflow step and defined in a template is "external_action." Further, lines 27-28 on page 50 describe how an entry in an event catalog may have a "path" value: "The "path" is the path for the external exc or dll to be launched." Based on this disclosure, as well as the disclosure originally cited as supporting claim 38, the applicants respectfully submit that claim 38 is amply supported by the specification and request the withdrawal of the rejection under § 112.

It is noted that the final office action, on page 3, states that "claim 37 introduces new matter and is rejected for failing to comply with the written description requirement." Because the remainder of the § 112 rejection, however, deals only with claim 38, the applicants assume that the reference to claim 37 is merely a typographical error. Assuming, however, that the Office did intend to reject claim 37 under § 112, ¶ 1, the applicants traverse that rejection as well. As noted in the applicants' prior amendment, claim 37 is supported by at least lines 4-6 on page 36, and 19-27 on page 49, of the application. Those respective passages are reprinted below:

> A lot of the tasks that are performed in the Identity System are accomplished using workflows. A workflow is a predefined set of steps that perform a specific task, where information or tasks are passed between participants and programs according to a defined set of rules.
>
> * * *
>
> A workflow is performed by one of the three managers described above (User Manager, Group Manager, Organization Manager). There may be cases when one workflow in one of the applications (e.g. user manger) needs to trigger a workflow in another application (e.g. Group Manager). For example, when creating a new user with a workflow in the User Manager, it may be beneficial for that workflow to trigger another workflow in the Group Manager which subscribes the new user to groups. A cross

application workflow is performed using the event catalog
described above, a client program and (optionally) a configuration
file for the client program, all of which will be described below.

Applicants submit that these passages, as well as other portions of the application, amply support claim 37, which recites "A method according to claim 1, wherein: said first workflow comprises a predefined set of steps that perform said task, said predefined set of steps comprising a first step and a second step; said first step is performed by a first program; said second step is performed by a second program; and information is passed between said first program and said second program according to a defined set of rules." Hence, to the extent the final office action rejects claim 37, reconsideration of that rejection is requested as well.

§ 103 Rejections

The final office action rejected claims 1-37 under § 103 as being unpatentable over the combination of Hardy and Howes. The applicants traverse the rejections of claim 1-37 under § 103(a). First, the final office action still fails to identify any suggestion or motivation to combine Howes and Hardy in the contemplated manner. The final office action states that "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to combine the two references since both were published and publicly available at the time of the invention." The office action also states that "both applications are directed toward directory services." While this line of argument might establish that Howes and Hardy possibly could be combined (although even this is doubtful), it fails entirely to establish any motivation or suggestion to combine the references in the manner contemplated by the final office action. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP § 2143.01. Neither the final office action nor the first office action establishes that the prior art suggests the desirability of the asserted combination, and the office actions therefore collectively fail to establish a prima facie case of obviousness, if for no other reason than this.

Moreover, even if combined, the Hardy and Howes references fail to teach or suggest each limitation of any pending claim. For example, as stated in the applicants' prior

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amendment, claim 1 recites "associating workflows with domains in a data structure" and
"performing a first workflow for said task, said first workflow is associated with a first domain
that includes the target of said request." While the final office action quibbles about the
semantics of the term "workflow" it still fails to identify any teaching in Hardy or Howes that
teaches either of these elements.

Even assuming that Howes teaches the concepts of domains and workflows
(which, for the reasons stated in their prior response, the applicants would dispute), the final
office action identifies nothing in either Hardy or Howes that would teach or suggest associating
a workflow with a domain. The final office action does argue that "Howes discloses several
detailed methods of associating these workflow processes with domains," but fails to identify
even a single example. While the initial office action cites pages 277-290 of Howes as teaching
this element of claim 1, those fourteen pages of Howes teach setting up a directory structure, but
notably absent from any of that disclosure is any mention of associating any process, let alone
any workflow process, with any particular domain (or, for that matter, any particular subdivision
of the directory). While the applicants are willing to concede that Howes does teach a
partitioned directory structure, even if this partitioned directory structure could be considered to
teach the concept of domains (although this again is not conceded), the final office action
identifies nothing—and applicants see nothing—in Howes that supports the Office's logical leap
from Howes' (purported) teaching of the concepts of domains and the recited element of
"associating workflows with domains in a data structure."

Similarly, even assuming the final office action is correct in its assertion that
Hardy somehow implicitly teaches workflows, both the initial and the final office action ignore
the text of the recited element when asserting that Hardy teaches "performing a first workflow
for said task, said first workflow is associated with a first domain that includes the target of said
request." Even if the initial office action's is correct that Hardy teaches workflows, the office
actions collectively fail even to argue that Hardy's workflows are "associated with a first domain
that includes the target of said request." As noted above, Howes fails to provide the missing

teaching, and this element of claim 1 therefore independently renders claim 1 allowable over the cited combination.

For at least the reasons stated above, neither the initial office action nor the final office action establishes a prima facie case that claim 1 is unpatentable under § 103(a). The rejection of claim 1, therefore, should be withdrawn and that that claim should be allowed. For at least similar reasons, independent claims 14 and 24 are believed to be allowable over the cited combination. Alternatively, the finality of the final office action should be withdrawn, and a new, non-final office action, with new grounds of rejection, should be provided.

Dependent claims 2-13, 15-23 and 25-38 are allowable as depending from allowable base claims and as being directed to specific novel substitutes. Merely by way of example, dependent claims 3, 16 and 26 recite "identifying one or more workflows associated with said target." Neither Hardy or Howes teaches this recitation. The office action states that "Hardy teaches a method of identifying applications associated with the target. . . . and associations of classes of users with applications . . . ." The cited portions of Hardy, however, do not appear to support the position taken by the office action. The cited portions of Hardy teach only that "[t]he server 102 also incorporates an authority application 154, which controls all exercise of enterprise authorities by the users Ui and coordinates all communications between the users Ui and their external correspondents" (c. 9, ll. 35-39), and "policy applications 170 [that] have features that can only be directed by respective classes of users according to a set of corporate policies" (c. 10, ll. 41-43). As stated in the applicants' prior amendment, the use of an authority application to control the use of authorities does not teach identifying an application associated with a user, contrary to the position taken by the office action. If anything, it teaches identifying <u>users</u> allowed to use an various "authorities" (that is, various roles of authority within a company), not identifying <u>workflows</u> (or, for that matter, applications or anything else) associated with a particular target.

The final office action fails to address this argument, dismissing it as "mischaracterize[ing] multiple passages of Hardy by pointing out that Hardy does not use exactly the same words to describe the claimed invention . . . ." This dismissal of the applicants'

arguments is not only incorrect, it is unfair. The office action fails to identify in Hardy any equivalent to a "target" as recited in the claims, such that Hardy could be read to teach "identifying one or more workflows associated with said target" as recited by claims 3, 16 and 26. Moreover, the initial office action fails to identify any process in Hardy that might be the equivalent of "identifying one or more workflows." As the applicants' prior amendment pointed out, Hardy teaches (if anything) identifying <u>users</u> that can use a particular role, not <u>workflows</u> associated with a particular target. The final office action states the Office's apparent belief that identifying a user is equivalent to identifying a workflow. The applicants respectfully submit that these two processes are in no way equivalent, and that claims 3, 16 and 26 are allowable for at least the additional reasons stated above.

Claims 9 and 20 recite that "said steps of associating, receiving and performing are performed by an integrated identity and access system." As pointed out in the applicants' prior response, Hardy does not teach an integrated identity and access system. Instead, Hardy (c. 5, ll. 6-14) teaches an authority server, which is a system "though which incoming and outgoing electronic communications are routed and, [that] in conjunction with [a] directory, performs whatever additional processing is required. The additional processing can include generating letterhead or authoritative signatures, encrypting the message, decrypting the message, logging the message or issuing binding electronic documents." The final office action, in dismissing the applicants' arguments on this point, stated that "the features on which applicant relies . . . are not recited in the rejected claim(s)." The reference to the specification, however, served only to point out to the Office that the terms "identity system" and "access system" are defined by the specification to mean something fundamentally different than the authority server of Hardy, and that Hardy's authority server is not "equivalent" to the "integrated identity and access system" recited by claims 9 and 20. Hence, neither the initial office action nor the final office action establishes that Hardy's authority server teaches or suggests the elements of claims 9 and 20, and those claims, therefore, are allowable for this additional reason.

With regard to the final office action's admonition that "one cannot show nonobviousness by attacking references individually where the rejections are based on

combinations of references," the applicants agree. Nonetheless, this rule does not allow the Office to assert a combination of references which fail, either collectively or individually, to teach each element of the rejected claim. See MPEP § 2143.03 ("To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.") In this case, the office action cited particular references as teaching certain elements, when in fact the cited reference, in each case, failed to teach the element for which it was cited. To point this out to the Office is not to impermissibly attack the references individually.

Claim 38

The applicants specifically note that claim 38 was rejected only under § 112, not under § 102 or § 103. Hence, if the rejection under § 112 is withdrawn, as it must be, claim 38 would stand as allowable. For at least this reason, the final office action should be withdrawn, and the Office should mail a new, non-final office action, if claim 38 is to be rejected under § 102 or § 103. Alternatively, an advisory action should indicate that claim 38 is allowable.

Conclusion

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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